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09/890,805	08/30/2001	Serge Restle	05725.0927	6749

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
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WASHINGTON, DC 20001-4413

EXAMINER
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WILLIAMS, LEONARD M

ART UNIT	PAPER NUMBER
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1617

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12/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/890,805

Applicant(s)

RESTLE ET AL.

Examiner

Leonard M. Williams

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24, 34-37, 49, 51, 74 and 75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24, 34-37, 49, 51 and 74-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                      | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

Detailed Action

***Re-Opening of Prosecution***

The applicant's filed an appeal brief on 09/18/2007 and after careful consideration the examiner has decided to withdrawal the finality of the last office action and issue a new final office action due to applicant's amendment of the claims received 06/21/2006.

***Status of Claims***

Claims 24, 34-37, 49, 51 and 74-75 are pending.

The rejections of the last office action are withdrawn and modified/new rejections based solely on the prior art of record are detailed below.

This action is made final.

***Response to Amendment***

The applicants fail to particularly point out where support for the proposed amendments lie. The applicants provide only a general and vague statement as follows: "Support for the above amendments can be found in the originally filed specification and claims." Applicants are required to distinctly point out where support lies for their proposed amendments. Despite this deficit the examiner has entered the amendments to the claims.

Applicant's amendment of the claims received 6/21/2006 amending claims 24, 34, 36, 49, 51, 74 and 75 has been entered.

Applicant's arguments with respect to claims 24, 34-37, 49, 51, 74 and 75 have been considered but are moot in view of the new rejection(s) necessitated by applicant's amendment.

The applicant's argue that the examiner has failed to meet every limitation of applicant's claims in the formulation of the 102(b) rejection of record. The applicant asserts, on pages 19-20 of the remarks, that Birtwistle fails to teach a composition comprising at least one of the recited esters in the claimed amount (1.2-8% by weight). The applicant then states on page 20 of the remarks, "...Birtwistle discloses that various emollients may be added to composition in an amount ranging from 0.01-99% by weight, such a disclosure does not teach the use of 1.2-8% of these emollients as recited in trhe present independent claims. Moreover, applicants submit while the examples of Birtwistle may teach compositions comprising various components falling within the claimed concentration range, such components do not anticipate the claimed at least one water insoluble ester." The examiner points out that the applicants herein support the anticipation rejection as made by the examiner by both admitting that Birtwistle teaches a range encompassing the applicant' said range and further that the Birtwistle compounds have been exemplified within the said ranges of the applicant's claims.

The applicant's repeatedly deny that Birtwistle teaches at least one of the claimed water-insoluble caboxylic acid esters in the claimed concentration. The

examiner respectfully disagrees. As has been demonstrated repeatedly in the rejection of the prior office action Birtwistle teaches the broadly claim esters.

The examiner respectfully points out, again, that the example 9 was set forth at the end of the rejection as one example presented in the Birtwistle reference. The remainder of the rejection addressed the limitations set forth in the applicant's claims. For clarification the examiner will address applicant's statement that the examiner asserts that ethylene glycol monostearate is equivalent to the at least one water-insoluble mono-carboxylic acid ester recited in the claims. In the office action of 02/07/2005 the examiner when presenting example 9 clearly indicates that ethylene glycol monostearate is a non-ionic surfactant and water insoluble ester. No assertion is made that ethylene glycol monostearate is a water-insoluble mono-carboxylic acid ester as recited in the claims. The examiner will point out that in the preceding parts of the 102(b) rejection the examiner pointed out that the Birtwistle et al. compounds included emollients including, isopropyl myristate, isopropyl palmitate, butyl stearate, butyl myristate, lauryl lactate and isopropyl linolate (in amounts of from 0.01-99%) all compounds meeting the various water-insoluble mono-carboxylic acid esters as recited in the claims. Further as applicant's have amended claim 49 to exclude glyceryl monostearate the examiner respectfully points out that the said claim also includes glyceryl monolaurate which is also included in Birtwistle as set forth in the prior rejection. Additionally the examiner would like to draw the applicant's attention to col. 5 line 35 to col. 6 line 10, of Birtwistle et al. where it is taught that the compositions can

include tallow fats and coconut oil (both containing triesters of glycerol fatty acids meeting the triesters as set forth in the applicant's claims) in amounts of up to 90%.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 24, 34-37, 49, 51 and 74-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Birtwistle et al. (US Patent No. 5139781).

Birtwistle et al. state, in col. 1 lines 5-13:

“The invention relates to compositions suitable for topical application to the skin, (including the mucosae), and to the hair. In particular, the invention is concerned with highly improved detergent compositions suitable for cleansing the whole body surface, including the mouth.”

Birtwistle et al. further teach, in col. 1 line 67 to col. 2 line 12:

“The compositions so obtained are accordingly capable of producing a superior lather volume and an outstanding lather creaminess. Also, the composition is so mild to the skin that it can safely be used for cleansing the mucosae, such as the mouth and the vagina, and other more delicate skin areas. It can also be used in shampoos for frequent, e.g. daily, hair washing, without risk of scalp irritation or damage attributable to harsher products. In addition to these excellent attributes, the ease of rinsing from hair

or skin and superior silky-smooth after-use skin feel properties of the compositions, including freedom from skin roughness and erythema, have great consumer appeal.”

Birtwistle et al. teach, in col. 2 lines 15-65, compositions suitable for topical application to the skin or hair, which comprise 1-99% of a monoalkyl or monoalkenyl phosphate surfactant (anionic surfactant), 1-50% of a dialkyl or dialkenyl phosphate surfactant (anionic surfactant) and 1-50% of a co-surfactant chosen from alkylamidobetaines (amphoteric surfactant) or alkylamphoglycinates (amphoteric surfactant). Birtwistle et al. teach, in col. 8 lines 15-65, that the compositions can also comprise non-ionic surfactants of up to 50% (preferably 1-40% by weight), such as alkylethoxylates, alkylalkanolamides, sucrose laurate, methyl glucose laurate, and esters of glycols and glycerols such as ethylene glycol mono stearate and glyceryl mono stearate. Birtwistle et al. teach, in col. 11 lines 5-30, that additional emollients can be used in the compositions including glyceryl monolaurate, glyceryl monostearate, isopropyl myristate, isopropyl palmitate, butyl stearate, butyl myristate, lauryl lactate, isopropyl linolate, and others. Birtwistle et al. teach, in example 9, a body shampoo for use in the shower or when bathing comprising triethanolammonium mono-(ethyleneglycol-mono-n-decyl ether) phosphate (an anionic surfactant, 10% by weight), triethanolammonium di-(ethyleneglycol-mono-n-octadecenyl ether) phosphate (an anionic surfactant, 8% by weight), cocoamphodipropionate (an amphoteric surfactant, 9% by weight), ethylene glycol monostearate (a non-ionic surfactant and water-insoluble ester, 1.5% by weight) and water anticipating the "...composition comprising (A) a cosmetically acceptable aqueous medium, (B) a washing base comprising at least

one anionic surfactant and at least one amphoteric surfactant, (C) at least one water-insoluble carboxylic acid ester...the concentration of said ester... 1.2 to 8% by weight...the concentration of said washing base...ranging from 6 to 35% by weight...the anionic surfactant:amphoteric surfactant ratio by weight being less than or equal to 3:1" of claim 24, The ..."composition wherein at least one water-insoluble carboxylic acid ester is chosen from..." of claim 34, the "...composition...wherein at least one esters is chosen form..." of claim 35, the "...composition...wherein said monocarboxylic acid...is chosen from..." of claim 36, the "...composition...wherein said monoalcohols...are chosen from..." of claim 37, the "...method for cleaning and/or removing makeup from a keratinous substance..." of claim 74, and the "...process for washing and for conditioning a keratinous substance..." of claim 75.

The examiner respectfully point out the following: "Products of identical chemical composition can not have mutually exclusive properties.

"A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present." *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and



the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birtwistle et al. (US Patent No. 5139781).

Birtwistle et al. teach, in col. 2 lines 15-65, compositions suitable for topical application to the skin or hair, which comprise 1-99% of a monoalkyl or monoalkenyl phosphate surfactant (anionic surfactant), 1-50% of a dialkyl or dialkenyl phosphate surfactant (anionic surfactant) and 1-50% of a co-surfactant chosen from

alkylamidobetaines (amphoteric surfactant) or alkylamphoglycinates (amphoteric surfactant). Birstwistle et al. teach, in col. 8 lines 15-65, that the compositions can also comprise non-ionic surfactants of up to 50% (preferably 1-40% by weight), such as alkylethoxylates, alkylalkanolamides, sucrose laurate, methyl glucose laurate, and esters of glycols and glycerols such as ethylene glycol mono stearate and glyceryl mono stearate. Birstwistle et al. teach, in col. 11 lines 5-30, that additional emollients can be used in the compositions including glyceryl monolaurate, glyceryl monostearate, isopropyl myristate, isopropyl palmitate, butyl stearate, butyl myristate, lauryl lactate, isopropyl linolate, and others. Birstwistle et al. teach, in example 9, a body shampoo for use in the shower or when bathing comprising triethanolammonium mono-(ethyleneglycol-mono-n-decyl ether) phosphate (an anionic surfactant, 10% by weight), triethanolammonium di-(ethyleneglycol-mono-n-octadecenyl ether) phosphate (an anionic surfactant, 8% by weight), cocoamphodipropionate (an amphoteric surfactant, 9% by weight), ethylene glycol monostearate (a non-ionic surfactant and water-insoluble ester, 1.5% by weight) and water.

Birstwistle et al. does not exemplify a non-ionic surfactant and water-insoluble ester other than ethylene glycol monostearate.

Birstwistle et al. (as described above) teach, in col. 11 lines 5-30, that additional emollients can be used in the compositions including glyceryl monolaurate, glyceryl monostearate, isopropyl myristate, isopropyl palmitate, butyl stearate, butyl myristate, lauryl lactate, isopropyl linolate, and others, all compounds meeting the water-insoluble mono-carboxylic acid esters described in claims 49 and 51.

It would have been obvious to one of ordinary skill in the art at the time the invention was made that Birtwistle et al. could use any of the described emollients including glyceryl monolaurate, glyceryl monostearate, isopropyl myristate, isopropyl palmitate, butyl stearate, butyl myristate, lauryl lactate, isopropyl linolate in place of ethylene glycol mono stearate as exemplified as Birtwistle et al. teaches the emollients as being equivalent and useful in the invention. One would be motivated to use any particular emollient in order to optimize and/or modify the properties of the overall composition based upon the desired end product (hair shampoo, body wash, etc...). One would have a reasonable expectation of success as Birtwistle et al. teaches the compounds as equivalent and simple replacement of one equivalent emollient for another is easily within the ability of one of ordinary skill in the art.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

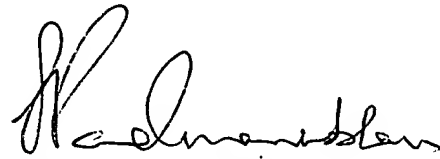
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard M. Williams whose telephone number is 571-272-0685. The examiner can normally be reached on MF 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LMW

  
SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER